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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/597,029	07/07/2006	Nobuo Nishioka	40815	5024

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EXAMINER	
NIGH, JAMES D	

ART UNIT	PAPER NUMBER
3685	

NOTIFICATION DATE	DELIVERY MODE
09/17/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/597,029	NISHIOKA ET AL.	
	Examiner	Art Unit	
	JAMES D. NIGH	3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 July 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *7 July 2006*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This communication is in response to application filed on 7 July 2006. Claims 1-7 were modified via preliminary amendment and claims 8-22 have been cancelled. Claims 1-7 are currently pending and are presented for examination on the merits.

Priority

2. Receipt is acknowledged of papers submitted 7 July 2006 under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

3. The information disclosure statement (IDS) was submitted on 7 July 2006. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. **Claims 1-7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

6. Claims 1 and 5 recite a terminal apparatus and a content usage management device comprised entirely of "units" which in the broadest reasonable interpretation could be comprised entirely of software which is non-statutory subject matter. Computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such

claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035. Accordingly, it is important to distinguish claims that define descriptive material per se from claims that define statutory inventions.

7. Claims 2-4 are also rejected as being dependent upon claim 1.

8. Claims 6-7 are also rejected as being dependent upon claim 5.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. **Claims 1-4 and 6-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

11. Claim 1 recites a terminal apparatus comprising a content usage management device further comprising a terminal time change notification unit. It is unclear if the terminal time change notification unit is part of the terminal apparatus, the content usage management device or both. For purposes of claim interpretation the terminal time change notification unit will be considered to be part of the terminal apparatus and

not part of the content usage management device. "An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed…", *In re Zletz*,13 USPQ2d 1320 (Fed. Cir. 1989).

12. Claims 4 and 7 recite "wherein, when the change-of-time detection unit has detected a change-of-time event of the terminal, the data communications unit acquires from the terminal a time thereof achieved immediately before change of time of the terminal and a time of the terminal achieved immediately after change of time of the terminal" which is reciting both an apparatus and a method for using the apparatus. It has been held that a claim that recites both an apparatus and a method for using said apparatus is indefinite under section 112. Therefore, as claims 4 and 7 possess such a deficiency it is rejected for failing to particularly point out and distinctly claim the invention (*IPXL Holdings LLC v. Amazon.com Inc.,* 77 USPQ2d 1140 (CA FC 2005); *Ex parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990)).

13. Claims 2-4 are also rejected as being dependent upon claim 1.

14. Claim 6 recites a content usage management device and further recites steps of transmitting, receiving, acquiring, computing, subtracting and updating which is reciting both an apparatus and a method for using the apparatus. It has been held that a claim that recites both an apparatus and a method for using said apparatus is indefinite under section 112. Therefore, as claim 6 possesses such a deficiency it is rejected for failing to particularly point out and distinctly claim the invention (*IPXL Holdings LLC v.*

Amazon.com Inc., 77 USPQ2d 1140 (CA FC 2005); *Ex parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990)).

15. Claims 7 are also rejected as being dependent upon claim 6.

Claim Rejections - 35 USC § 102

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

17. **Claims 1, 2 and 5 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by McKune (U.S. Patent PG Publication 2002/0169974, now U.S. Patent 7,134,144, hereinafter referred to as McKune).**

18. As per claims 1, 2 and 5

McKune discloses a terminal time change notification unit which automatically notifies the content usage management device of change of time of the terminal apparatus (0445-0448)

McKune discloses a change-of-time detection unit which receives a notification of change from the terminal apparatus and detects a change-of-time event at the terminal apparatus (0452-0462)

McKune discloses a control unit which updates limitation-on-usage information about the contents in accordance with the detected change of time (0452-0462).

McKune discloses “wherein, when the change-of-time detection unit has detected the change-of-time event of the terminal, the control unit updates the limitation-on-

usage information" (0452-0460). However as this is prefaced by the word "when" the limitation is only performed optionally and therefore does not further limit the claim. See MPEP § 2106 II C.

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

20. **Claims 3-4 and 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over McKune.**

21. As per claims 3 and 6

McKune discloses wherein the content usage management device further comprises a data communication unit which transmits and receives data to and from at least a terminal (0040, 0044)

McKune discloses "wherein the limitation-on-usage information includes expiration date information showing an expiration time by which content can be used and reference time information showing a reference time which serves as a reference for limitations of usage of the contents" (0446-0448, 0451-0453). Additionally this is simply descriptive material and as the claimed data has no manipulative effect on any of the structure it is nonfunctional in nature and therefore is not entitled to any patentable weight "Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability ….

[T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate" *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II, "We conclude that when the prior art describes all of the claimed structural and functional relationships between descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the claimed descriptive material is non-functional and will not constitute a sufficient difference from the prior art to establish patentability", *Ex parte Halligan*, 89 USPQ2d 1355 (Bd. Pat. App. & Int. 2008).

McKune discloses "wherein, when the contents are acquired, the data communications unit transmits and receives data to and from a content distributor which distributes the contents, acquires a remaining time of validity of the contents from the content distributor as the expiration date, and acquires from the terminal a current time thereof" (0014, 0037, 0049, 0051, 0058, 0061, 0107, 0158, 0355, 0370-0371, 0395, 0401, 0451-0453). However as this is prefaced by the word "when" the limitation is only performed optionally and therefore does not further limit the claim. See MPEP § 2106 II C.

McKune does not explicitly disclose "wherein, when the change-of-time detection unit has detected a change-of-time event of the terminal, the control unit computes a time during which the contents have been used, by means of subtracting the reference time from the time of the terminal, computes an expiration date achieved immediately after change of the time of the terminal be means of subtracting the time during which

the contents have been used from the expiration time achieved immediately before change of time of the terminal, and updates limitation-on-usage information by means of taking the time of the terminal achieved immediately after change of the time of the terminal as a new reference time". McKune does teach that the amount of rollback may be determined (0451), that the new current time may be used as part of the determination (0449), adjustment of stored state time (0449), modification of the license following a detected rollback (0454-0460) and that a course of action is taken upon detection of rollback (0448, 0452, 0454). Therefore a predictable result (*KSR International Co. v. Teleflex Inc.,* 82 USPQ2d 1385 (U.S. 2007)) of McKune would be to modify the license following a detected rollback to have an expiration date that is shifted by the amount of detected rollback for the purpose of establishing a controlled rendering environment allows that the digital content will only be rendered as specified by the content owner, even though the digital content is to be rendered on a computing device which is not under the control of the content owner. However as this is prefaced by the word "when" the limitation is only performed optionally and therefore does not further limit the claim. See MPEP § 2106 II C.

22. As per claims 4 and 7

McKune does not explicitly disclose "wherein, when the change-of-time detection unit has detected a change-of-time event of the terminal, the data communications unit acquires from the terminal a time thereof achieved immediately before change of time of the terminal and a time of the terminal achieved immediately after change of time of the terminal"; however McKune discloses performing a determination of the amount of

temporal rollback (0451). However as this is prefaced by the word "when" the limitation is only performed optionally and therefore does not further limit the claim. See MPEP § 2106 II C.

Please note:

A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Applicant(s) are reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See *e.g.* MPEP §2106 II C: "Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.]"; and *In re Johnston,* 435 F.3d 1381, 77 USPQ2d 1788, 1790 (Fed. Cir. 2006) ("As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted.").

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES D. NIGH whose telephone number is (571)270-5486. The examiner can normally be reached on Monday-Thursday 6:45-5:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin L. Hewitt II can be reached on 571-272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JAMES D NIGH/
Examiner, Art Unit 3685

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685